

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appl. No. 10/807,196  
Attorney Docket No.: Q78011

### **REMARKS**

Claims 1-11 are all the claims pending in the application. Claims 2, 4, and 7-11 are withdrawn from consideration as being drawn to a non-elected invention and are canceled without prejudice or disclaimer. By the Amendment, Applicant adds claims 12-31, which are clearly supported throughout the specification.

#### **I. Preliminary Matters**

The Examiner has acknowledged Applicant's claim to foreign priority and has indicated receipt of the certified copy of the Priority Document. The Examiner has returned the initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on May 21, 2004.

Applicant respectfully requests the Examiner to indicate acceptance of the drawings filed on March 24, 2004.

#### **II. Summary of the Office Action**

Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. § 101 and 102.

#### **III. Claim Rejections under 35 U.S.C. § 101**

Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to a non-statutory subject matter. In particular, the Examiner alleges that the claims do not recite physical structures and are software per se, not embodied on a computer-readable medium (*see* pages 2-3 of the Office Action). Applicant respectfully traverses this rejection in view of the following comments.

Claims 1, 3, 5, and 6 clearly describe a physical structure. For example, claim 1 recites "an article identification means for acquiring identification information to identify an individual

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article,” claim 3 recites “a position information acquisition means for acquiring position information to identify a specific position on an individual article.”

Clearly, the article identification means and the position information acquisition means cannot be purely software because it is impossible to identify the article (claim 1) or a position in the article (claim 3) with software alone. Identifying the article or the specific position on the article would require at least some hardware such as a sensor or an image device. Furthermore, the related information input means and the message recording means recited in claims 1 and 3 must also contain some sort of hardware. In short, the physical structures being recited in claims 1 and 3 are not purely software.

Furthermore, claim 5 recites “an integrated circuit tag sensor” and “a content recording medium.” Clearly, an integrated circuit tag sensor and a recording medium are hardware. Accordingly, claim 5 recites a physical structure and is not purely software.

Claim 6 recites: “a detection means detecting a predetermined position of a surface of content recording medium.” Clearly, detecting position on the surface of the content recording medium would require some sort of hardware such as an image device, a sensor, etc. In short, the detection means cannot comprise software alone. Accordingly, claim 6 recites a physical structure.

In view of the foregoing comments, Applicant respectfully requests the Examiner to withdraw this rejection under 35 U.S.C. § 101 of claims 1, 3, 5, and 6.

IV. Claim Rejections under 35 U.S.C. § 102

Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,741,864 to Wilcock et al. (hereinafter “Wilcock”). Applicant respectfully traverses these rejections in view of the following comments.

The Examiner contends that Wilcock suggests each feature of the independent claims 1, 3, 5, and 6. This rejection is not supportable for at least the following reasons.

Claim 1 recites “article identification means for acquiring identification information to identify an individual article.” The Examiner alleges that associating digital photo with a location discloses the article identification means. The Examiner further contends that the article is a “thing” and Wilcock’s digital photo is a “thing,” as such the digital photo of Wilcock discloses the article set forth in claim 1 (*see* pages 3-4 of the Office Action). Applicant respectfully disagrees.

It is noted that to be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

A digital photo is binary data.<sup>1</sup> In other words, a digital photo is a signal carrying information. Clearly, this signal carrying information cannot and would not be interpreted as a “thing”. Furthermore, a digital photo (binary data) is clearly not an article.

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<sup>1</sup> [http://en.wikipedia.org/wiki/Digital\\_photo](http://en.wikipedia.org/wiki/Digital_photo), last visited July 28, 2006.

In addition, the Examiner's reasoning is logically flawed. The logical flaw in this reasoning is demonstrated with the following example. An apple is a fruit (just like an article is in a group of a "thing") and a banana is a fruit (assuming *arguendo* binary data can somehow qualify as a "thing") from these two statements, the Examiner concludes that a banana (digital photo) discloses an apple (an article). In short, the Examiner's reasoning is logically flawed.

Also, interpreting the digital photo of Wilcock as disclosing "an article" set forth in claim 1 contradicts the field of the claimed invention. That is, the claimed invention is in a field of: "message is input or related information is specified to a content recorded onto a physical recording medium such as a book, notebook, or paper..." (page 1 of the specification). In other words, Wilcock relates to linking a location and other information to a digital photo and not to a portion of a physical object such as a book, a notebook, and so on. For the digital data, such as the data disclosed in Wilcock, related information (location, description, and so on) may be easily edited, deleted, and added. Wilcock, however, fails to disclose or suggest identifying an individual article (a physical item) and linking the related information to that physical item. In short, Wilcock's technique is incapable of maintaining the appearance of the article by not degrading it with rewrites and corrections, which updating the related information as many times as necessary.

In summary, the deficiencies of the Wilcock reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 1 is patentable.

Independent claim 3 recites: “position information acquisition means for acquiring position information to identify a specific position on an individual article; related information input means for inputting related information related to said specific position on said individual article.”

The Examiner contends that the digital image of Wilcock is the article and that location data is the position information as set forth in claim 3. As explained above with respect to claim 1, the digital image does not disclose or suggest an article within the meaning of claim 3. Furthermore, in Wilcock, the location is linked to an image and not to a specific position on the image (alleged article). That is, Wilcock fails to disclose or suggest identifying a specific position on the image and linking that specific position with related information. In Wilcock, only the entire image is linked with location and other fields (col. 4, lines 41 to col. 5, line 2).

In summary, the deficiencies of the Wilcock reference fall to the Examiner’s burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 3 is patentable.

Independent claim 5 recites: “photographing means for photographing a content recording medium to which an integrated circuit tag is affixed; an integrated circuit tag sensor for communicating with said integrated circuit tag affixed to said content recording medium;... related information input means for inputting related information related to said predetermined position in said content recording medium.”

In Wilcock, there is no disclosure of suggestion of photographing the content recording medium. In other words, Wilcock does not disclose or suggest photographing a photo, a book, or

a disk. In short, if, as alleged by the Examiner, a photo is the content recording medium, then clearly, Wilcock does not disclose or suggest photographing the photo.

Further, in Wilcock, there is no disclosure of an integrated circuit tag being affixed to the photo. The Examiner contends that the digital photo is tagged with location and as such Wilcock discloses having an integrated circuit tag affixed to the content recording medium (*see* page 5 of the Office Action). Applicant respectfully disagrees. The digital location stamp of Wilcock cannot and does not disclose an integrated circuit tag.

In addition, in Wilcock there is no disclosure or suggestion of the digital location stamp (alleged location tag) communicating with the sensor. In addition, it is respectfully noted that in Wilcock, the location and other information are linked to the digital photo and not to a specific position on the content recording medium.

In summary, the deficiencies of the Wilcock reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 5 is patentable.

Independent claim 6 recites: "detection means for detecting a predetermined position on a surface of a content recording medium on said surface of which a predetermined pattern is formed by specifying said predetermined pattern on said content recording medium;...related information input means for inputting related information related to said predetermined position in said content recording medium."

The Examiner's grounds of rejection with respect to claim 6 are not understood. The Examiner alleges that "a message" is a "thing" and that Wilcock's photos are "a thing."

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Accordingly, the Examiner now alleges that Wilcock's photos disclose a message (*see* page 7 of the Office Action). In short, the position set forth in the Office Action may be summarized as follows: a message, a photo, an article, a content recording medium are all things and since they are all things, they all identically disclose each other as required under 35 U.S.C. § 102. The logical flaw of this argument has been explained above with respect to claim 1.

Further, the Examiner appears to alleges that a map-based interface having markers indicating the points where various images were taken disclose the detection means, as set forth in claim 6 (*see* page 6 of the Office Action). Applicant respectfully disagrees.

Wilcock discloses displaying a map area and a marker 64, which shows on the map the location where the photo is taken (Fig. 6, col. 12 to 26). However, the digital map of Wilcock is not a content recording medium. The digital map is binary data and not a content recording medium. In other words, the map information of Wilcock may be recorded on the content recording medium but is not itself the content recording medium.

In summary, the deficiencies of the Wilcock reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 6 is patentable.

#### V. New Claims

In order to provide more varied protection, new claims 12-31 are added. Claims 12-25 are patentable at least by virtue of their dependency on claim 1, 3, 5, or 6.

New claims 26 is patentable at least by virtue of its recitation of "obtaining, by at least one of a camera and a sensor, identification information of a tangible recording medium ...

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recording by a computer the input message together with the identification information of the tangible recording medium.” Claims 27-31 are patentable at least by virtue of their dependency on claim 26.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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